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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,027	01/24/2002	Friedrich Jonas	Mo6935/LcA 34,765	3582
23416 7590 12/19/2007 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1796	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/057,027  
Filing Date: January 24, 2002  
Appellant(s): JONAS ET AL.

**MAILED**  
**DEC 19 2007**  
**GROUP 1700**

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 02 October 2007 appealing from the Office action mailed 22 September 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following rejection is made in the alternative to the rejections base on the prior are rejections, which follow.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which does not have an adequate written description. The making of the poly(3,4-ethylenedioxythiophene) is deemed critical or essential to the practice of the invention, but not included in the specification or the claim(s) and thus is not adequately described by the disclosure.

Appellants (page 4 of the response filed September 9, 2004) state that one having ordinary skill in the art would **not** know how to make the claimed **dispersions** and further state that the examiner has not provided a *prima facie* case of obviousness regarding the making of the poly(3,4-ethylenedioxythiophene). Applicants improperly

reference non-English language foreign references describing how said materials are made. Said references are **not** incorporated by reference.

The skilled artisan, having the originally filed specification in light of appellants' admission, would **NOT** have known how to make applicants invention as filed by the original description. The only reasonable conclusion is that the making of the inventive dispersions is not adequately described to one having skill in the art.

#### **(10) Response to Argument**

The facts of the case appear as follows:

(1) The originally filed disclosure sets forth:

The invention therefore relates to 3,4-polyalkylenedioxythiophene dispersions in which at least about 90% of the particles are less than about 50 nm and the resistivity of coatings produced therefrom is preferably more than about 5000  $\Omega\text{cm}$ . Preference is given to dispersions in which at least about 90% of the particles are less than about 40 nm.

The particle size . . . . These dispersions were prepared starting from dispersions in accordance with EP-A 991 303 by subsequent comminution of the particles.

Suitable comminution methods are, for example, grinding by means of ball mills or stirred mills, high-speed stirring, ultrasound treatment and high-pressure homogenization.

EP 0991303 is further referenced at page 3, lines 3 and 12; page 4, line 7; and the examples 1-3 at about lines 4 or 5 of each. EP 0991303 is in other than the English language, i.e., German, and the instant disclosure does not disclose how to make the dispersions of example 2 of EP 0991303.

(2) The EP 0991303 is **NOT** incorporated by reference as set forth in 37 CFR 1.57(b)(1).

(3) Applicants (page 4 of the response filed September 9, 2004) state that one having ordinary skill in the art would **NOT** know how to make the claimed dispersions and further state that the examiner has not provided a *prima facie* case of obviousness regarding the making of the poly(3,4-ethylenedioxythiophene).

Conclusion to the above facts:

The skilled artisan, having the originally filed specification in light of appellants' admission, would **NOT** have known how to make applicants invention as filed by the original description. The only reasonable conclusion is that the making of the inventive dispersions is not adequately described to one having skill in the art.

(I) Appellants (page 5 of Brief) assert the advisory action statement by the examiner that "Applicants arguments are not deemed persuasive as they do not address that the subject matter is essential subject matter" is traversed based on the reference to example 2 of EP 0991303. Appellants (pages 5 and 6) assert the first step of preparing is in accordance with example 2 of EP 0991303 and said reference is set forth in all the instant examples.

This has not been deemed persuasive since: (1) the reference (EP 0991303) thereto is of a German language document and (2) The reference (EP 0991303) has **NOT** been incorporated by reference.

(II) Appellants (pages 6 and 7) assert the examiner has wrongly quoted appellants' statement at page 4 of the September 9, 2004 response. This has not been deemed

persuasive since the appellants assert at page 4, lines 25-26, last full paragraph: "The Office Action does not establish any support for the allegation that one of ordinary skill in the art would know how to make 3,4-polyalkylenedioxythiophenes."

The above quote is summarized in the rejection and conveniently omitted from appellants' reproduced quote appellants' statements. Considering the facts as a whole (i.e. essential subject matter cited in foreign language documents, statements that the claimed invention would not be known to those skilled in the art, and statement that there is no evidence of record supporting that "one of ordinary skill in the art would know how to make 3,4-polyalkylenedioxythiophenes."), the only reasonable conclusion is that the appellants have failed to provide an adequate written description to the public for the patent sought.

(III) In conclusion: regardless of appellants' statement (page 4, response of September 9, 2004), the originally filed disclosure fails to properly provide an adequate written description since the materials employed are only described in terms of a reference in other than English and said reference was not incorporated by reference.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

**(12) Applicants' Evidence Appendix**


Although evidence is listed in the appendix (5 items), the Brief does not rely on said evidence.

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Art Unit: 1796


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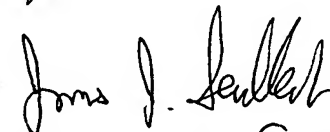
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1796

Conferees:

  
Romulo H. DeLmendo  
Appeal Conferee

  
James J. Seideck  
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